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Paper No. 10

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In re Application of :
Patrick H. Potega :
Application No. 09/475,946 :
Filed: December 31, 1999 :
Title of Invention: :
Hardware for Configuring and :
Delivering Power :
:

COPY MAILED

OCT 21 2003

OFFICE OF PETITIONS

This is a decision on the Request for Reconsideration of Petition Under 37 CFR 1.137 To Revive For Patent Abandoned Unavoidably, filed on August 27, 2003, to revive the above-identified application.

The petition is **DISMISSED**.

Any further petition to revive the above-identified application must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Request for Reconsideration of Petition under 37 CFR 1.137." This is **not** final agency action within the meaning of 5 U.S.C. § 704.

After a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Commissioner. Therefore, it is extremely important that petitioner supply **any** and **all** relevant information and documentation with his request for reconsideration. The Commissioner's decision will be based solely on the administrative record in existence. Petitioner should remember that it is not enough that the delay was unavoidable; petitioner must prove that the delay was unavoidable. A petition will not be granted if petitioner provides insufficient evidence to "show" that the delay was unavoidable. Therefore, if a request for reconsideration is filed, it must establish that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable.

Background

The above-identified application became abandoned for failure to timely and properly reply to the Office communication, mailed September 9, 2002, which set a shortened statutory period for reply of one (1) month. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on October 10, 2002. A Notice of Abandonment was mailed on May 19, 2003.

A petition under 37 CFR 1.137(a), filed July 11, 2003, was dismissed in a Decision mailed July 31, 2003, for failing to meet the requirements of a grantable petition under 37 CFR 1.137(a). In the July 11, 2003 petition, Applicant asserted, in relevant part, that the delay in responding to the September 9, 2002, Office communication was unavoidable because of the actions or inactions of his Attorneys. Applicant also failed to file a reply to the Office Communication.

Applicable Law

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by: (1) the required reply (unless previously filed), which may be met by the filing of a notice of appeal and the requisite fee; a continuing application; an amendment or request for reconsideration which *prima facie* places the application in condition for allowance, or a first or second submission under 37 CFR 1.129(a) if the application has been pending for at least two years as of June 8, 1995, taking into account any reference made in such application to any earlier filed application under 35 USC 120, 121 and 365(c); (2) the petition fee as set forth in 37 CFR 1.17(1); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c). The instant petition lacks item (3).

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present. In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

Applicant is further advised that the Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and applicant is bound by the consequences of those actions or inactions. Link v. Wabash, 370 U.S. 626, 633-34 (1962); Huston v. Ladner, 973 F.2d 1564, 1567, 23 USPQ2d 1910, 1913 (Fed. Cir. 1992); see also Haines v.

Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (D.N. Ind. 1987). Specifically, petitioner's delay caused by the actions or inactions of his voluntarily chosen representative does not constitute unavoidable delay within the meaning of 35 U.S.C. 133 or 37 CFR 1.137(a). Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (D. Ind. 1987); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (Comm'r Pat. 1891). In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

Finally, a "delay (in responding) resulting from the lack of knowledge or improper application of the patent statute, rules of practice, or MPEP, [] does not constitute unavoidable delay." MPEP 711.03(c).

Applicant's Assertion

Applicant asserts that his delay in responding to the Office communication, mailed September 9, 2002, was because the Office failed to receive and/or act upon his change of correspondence address and subsequently re-mail the September 9, 2002, Office Communication.

Applicant avers that he was contacted by the Examiner On October 3, 2002, with a request to file by "telefax", a Change of Correspondence Address, so that Applicant could receive a copy of the September 9, 2002, office Communication. Applicant further asserts that he did in fact send, via facsimile, a Change of Correspondence Address on October 3, 2002, with six days remaining in the one-month period for reply to the September 9, 2002 Office communication. Moreover, Applicant asserts that he sent via facsimile two other Change of Correspondence Addresses on April 29-30, 2003, and it was not until a fourth Change of Correspondence Address, sent via facsimile on May 9, 2003, that Applicant received the Office communication of September 9, 2002. Because of these putative bona fide efforts to advance the application, Applicant contends that the abandonment was unavoidable on his part.

Applicant also notes that the Examiner was aware that Applicant's then attorney of record would withdraw, and it was "proper" for the Examiner to contact the Applicant and request the Correspondence Address Change. Applicant supports this assertion with 37 CFR 1.33(a), where it states that, if more than one correspondence address is specified, the Office will establish one as the correspondence address. Reconsideration at p.3. However, at no time in either this or the original petition has petitioner asserted that more than one correspondence was specified. At all times, Applicant has asserted that the Office failed to timely receive and reply to his Correspondence Address Change. Applicant notes that it was this Office - the Examiner - who contacted Applicant. Applicant did not contact this Office with a change in correspondence address until after. Accordingly, 37 CFR 1.33(a) is inapposite.

Applicant has not provided an adequate showing of unavoidable delay

As to item (3), Applicant has not demonstrated unavoidable delay.

Applicant's focus is on the period of time after the September 9, 2002 Office communication was mailed. However, it is the period of time prior to the mailing of the September 9, 2002 Office communication that has led to the Office communication not being received by the Applicant. In this regard, the Office properly mailed the September 9, 2002 communication to the correspondence address of record. Thereafter, it was Applicant's responsibility to reply to the Office communication. It was not the responsibility of this Office to re-mail the Office communication once a new correspondence address had been filed.

Moreover, applicant was aware that his then Attorney of Record was going to withdraw as attorney of record. Applicant states that he received a collection letter from his then Attorney of Record to the effect that, if the attorney did not receive the full balance of Applicant's account, then Applicant was to consider the April 2, 2001 letter as advance notice of the Attorney's withdrawal of his power of attorney. *July 11 Petition* at p.2 Applicant further admits that this was the third such letter; however, Applicant did not consider this as "advance notice" as a proper notice of withdrawal under 37 CFR 1.36. *Id.* Applicant was also aware that the withdrawal was to take effect on April 20, 2001. *Id.* However, Applicant failed to notify this Office and failed to timely file a Change of Correspondence Address.

Applicant also asserted that it was the responsibility of his then Attorney of Record to notify this Office of the change of correspondence address¹. Applicant is again advised that Applicant is bound by the actions or inactions of duly authorized and voluntarily chosen representatives.

In this Reconsideration Request, Applicant emphasizes that neither of his former attorneys of record were duly authorized by Applicant to act on Applicant's behalf, nor could they in any way be considered Applicant's representative. *Reconsideration Request* at p.5. Applicant admits that "these attorneys had disassociated themselves from applicant over a year prior to September 2002, they were not under applicant's control or even influence, therefore, Applicant should not be bound by their actions or inactions". *Id.*

In this Reconsideration Request, Applicant appears to recognize that control of the prosecution of the application rested with Applicant for "over a year prior to September, 2002"; however, Applicant failed to file a Change of Correspondence Address until April 29, 2003², and then only after having been contacted by this Office.

¹ Applicant asserts in the original petition of July 11, 2003, that his then attorney of record "should have notified any and all Examiners that may have contacted him of [Applicant's] correspondence address". *Petition to Revive, July 11, 2003* at p.4.

² Applicant asserts that he filed a Change of Correspondence Address on October 22, 2003. Applicant is advised that there are three methods of filing correspondence with this Office wherein the correspondence will be considered timely filed in the event that the correspondence is not received by this Office. The first method is where correspondence has been filed using Express Mail Service of the United States Postal Service. That method is inapplicable here.

The second method, applicable here, is correspondence filed with this Office that includes a Certificate of Mailing (if mailed) or Transmission (if sent via facsimile) under 37 CFR 1.8. A review of the Office file reveals that Applicant did not include a Certificate of Facsimile Transmission on the Change of Correspondence Address, filed April 29, 2003. A further review of the file reveals that Applicant received an Auto-Reply Facsimile Transmission from this Office on October 22, 2003, indicating receipt of the Change of Address; however, the Change of Address does not include a Certificate of Transmission. A further review of the Auto-Reply Facsimile Transmission reveals that Applicant was advised therein to use the Certificate of Facsimile Transmission procedures set forth in 37 CFR 1.8(a) and (b), and 37 CFR 1.6(f). Having failed to include a certificate of Facsimile Transmission, the correspondence may not be considered filed on the date of the transmission, but must be considered filed on the date it was received in the Office, April 29, 2003.

While Applicant may have been unaware of the rules of practice regarding the timely filing of correspondence, this does not form the basis for an unavoidable delay. Nonawareness of the content of, or a misunderstanding of, PTO statutes, PTO rules, the MPEP, or Official Gazette notices, does not constitute unavoidable delay.³

Applicant argues that "[n]o reasonable or prudent foresight on [his] part could have prevented the attorney's not under [his control] from failing to perform their normally anticipated action of properly withdrawing" *Id.* Applicant is again apparently asserting - when he asserts that the attorney's "fail[ed] to perform their normally anticipated action of properly withdrawing" - that the former attorneys of record bear some responsibility for filing a correspondence address change. However, Applicant takes issue with the reason for dismissal in the Decision mailed July 31, 2003. Applicant states that a finding that the delay was not unavoidable because of the actions or inactions of his attorneys is not supported by the facts as put forth in Applicant's original petition, "wherein distinctly and repeatedly applicant asserts the [then attorney's of record] were not in any capacity acting as applicant's attorneys". *Reconsideration Request* at p.6.

This Office apologizes for any misinterpretation of the original, July 11, 2003 petition. To clarify, in view of the fact, asserted repeatedly herein and in Applicant's original, July 11, 2003 petition, that Applicant was not represented by attorneys Hollingsworth or Abrahams for over a year prior to the mailing of the September 9, 2002 Office communication, then it

The third method of corresponding with this Office wherein the Office will consider the correspondence as having been timely filed, is where correspondence that is filed using the U.S.P.S. includes a return-receipt postcard that has been properly itemized by Applicant. This Office will date-stamp the return-receipt postcard evincing receipt of the items listed on the reverse side of the postcard, and mail it back to an Applicant. That method is also not applicable here.

³ See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (*citing Potter v. Dann*, 201 U.S.P.Q. (BNA) 574 (D. D.C. 1978) for the proposition that counsel's nonawareness of PTO rules does not constitute "unavoidable" delay)); Vincent v. Mossinghoff, 1985 U.S. Dist. LEXIS 23119, 13, 230 U.S.P.Q. (BNA) 621 (D. D.C. 1985) (Plaintiffs, through their counsel's actions, or their own, must be held responsible for having noted the MPEP section and Official Gazette notices expressly stating that the certified mailing procedures outlined in 37 CFR 1.8(a) do not apply to continuation applications.) (Emphasis added).

was Applicant's responsibility to ensure that the correspondence address of record was an accurate correspondence address.

Thirty seven CFR 1.33 provides that "[t]he applicant, the assignee(s) of the entire interest (see 37 CFR §§ 3.71 and 3.73) or an attorney or agent of record (see § 1.34(b)) may specify a correspondence address to which communications about the application may be directed." (Emphasis supplied).

A review of the record indicates no irregularity in the mailing of the September 9, 2002 office communication, and in the absence of any irregularity there is a strong presumption that the communications were properly mailed to the applicant at the *correspondence address of record*. (Emphasis supplied).

In conclusion, this Office finds that a reasonable and prudent person, in relation to their most important business, would have timely and properly filed a Change of Correspondence Address with this Office.

Alternate Venue

Applicant is again strongly urged to file a petition stating that the delay was unintentional. Public Law 97-247, § 3, 96 Stat. 317 (1982), which revised patent and trademark fees, amended 35 U.S.C. § 41(a)(7) to provide for the revival of an "unintentionally" abandoned application without a showing that the delay in prosecution or in late payment of an issue fee was "unavoidable." This amendment to 35 U.S.C. § 41(a)(7) has been implemented in 37 CFR 1.137(b). An "unintentional" petition under 37 CFR 1.137(b) must be accompanied by the required petition fee.

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay can not make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if Applicant intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

Petition under 37 CFR 1.137(b) for unintentional abandonment

A grantable petition under 37 CFR 1.137(b)⁴ must be accompanied by: (1) the required reply,⁵ unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(c).

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
 PO Box 1450
 Alexandria, VA 22313-1450

By facsimile: (703) 308-6916
 Attn: Office of Petitions

By hand: Office of Petitions
 2201 South Clark Place
 Crystal Plaza 4, Suite 3C23
 Arlington, VA 22202

Telephone inquiries concerning this decision should be directed to the undersigned at 703-305-0014:

Derek Woods
Derek L. Woods
Petitions Attorney
Office of Petitions

⁴ As amended effective December 1, 1997. See Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53194-95 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 119-20 (October 21, 1997).

⁵ In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.